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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	020748.0104PTUS	9954

44124 7590 11/05/2008  
PATTON BOGGS, LLP  
2001 ROSS AVENUE, SUITE 3000  
DALLAS, TX 75201

EXAMINER
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FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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11/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

The examiner is in receipt of applicant's response to office action mailed 4/2/2008, which was received 7/29/2008. Acknowledgement is made to the amendment to claims 8 and 9. The amendment has overcome the USC 101 rejection of the last office action therefore that rejection has been obviated. Applicant's arguments and amendments in regards to the rejection on the merits has been carefully considered, but was not found to be persuasive, therefore the previous rejection is rested below:

### **Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Priority***

The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the

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requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/138,509, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In this case the provisional application does not provided support for bidding in “spot markets” as described in the claims and specification pages 18 and 19 with particular attention to the feature preventing the requester from accepting the identical response after the session is terminated.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1,2,4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoham et al (6,584,451) in view of Official Notice and further in view of Hanson (US 5974398) and further in view of Fusz (US 7,133,835) and further in view of Telezoo (an article found in PTO 892).**

**In regards to claims 1,2,4-9**, Shoham teaches all the features of the instant claims except as noted below. For instants, Shoham discloses saving pricing schedules

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to a database for a third party to provide responses to RFQs (col 5, lines 15-65, Fig 1), receiving a request after the schedules have been saved in the database (FIG 4), preventing a requester from accepting the identified response after the session is terminated by the requester (col 6, lines 1-8, since the buyer needs to be committed (in session) in order to maintain the current schedule, withdrawing or terminated the session would result in the buyer being subject to a new schedule if they decide to enter a new session) and preventing a service provider from modifying the set of responses during the session (col 6, lines 1-8).

Shoham discloses a method and system according to claim 1,8 and 9 as indicated supra, but does not specifically mention that the sales area is limited by the seller. Hanson teaches matching buyers to sellers in a specified geographical region (Hanson, FIG 2 and 3, col 6, lines 20-40). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Shoham limiting the area that a seller wishes to target, because this will reduce costs and increase revenue by only selling to buyers who are local and can be serviced in an inexpensive manner (see Fusz col 2, lines 15-20).

**In regards to claims 1,2,4-9,** Shoham discloses a method and system according to claim 1,8 and 9 as indicated supra. Shoham does not expressly disclose the purchasing of telecommunication services. Shoham does disclose online sales useful for a plurality of generic goods and services (Shoham: abstract). The differences, not including telecommunication services explicitly is only found in the non-functional data stored. Data identifying a product useful to a particular business is not functionally

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related to the substrate of the invention. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the invention as shown in Shoham, because such data does not functionally relate to the substrate of the invention and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Although the examiner does not acquiesce that the use of Telecommunications as a non-limiting factor, the examiner provides Telezoo as an example of a company that sells telecommunication products through a RFP process that allows users to compare prices (see entire article). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include selling telecommunications, because this would increase the revenue to a site by including what might amount to a billion dollars in sales through the portal.

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see *Sakraida*, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there

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respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

### ***Response to Arguments***

Applicant's arguments filed 7/29/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that Shoham, Hanson, Fusz and Telezoo are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all the references are related to selling and buying products in an E-commerce environment.

Applicant argues that Shoham does not teach "preventing a requester from accepting the identified response after a session has terminated". The examiner disagrees and further directs applicant's attention to Shoham col 7, lines 15 and 16 and col 8, lines 18-41, where it is clear that once the requests are prevented after termination of the session in the statement "The OBCS could stop receiving buy bids (terminate session) ...Any buyers in the process of submitting a bid would be out luck." Thus the requester is prevented from accepting the response after the session is terminated.

### **Conclusion**



**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300**

[Official communications; including

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After Final communications labeled

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For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Primary Examiner, Art Unit 3625